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09/378,678	08/20/1999	MARY K. MCCARTY	1002JJ-35352	9419

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EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/378,678
Filing Date: August 20, 1999
Appellant(s): MCCARTY ET AL.

MAILED
JUL 27 2004
GROUP 3600

Jonathan E. Jobe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 17 May 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows: Claims 6-32 are pending. Claims 1-5 and 33-39 previously canceled. The claims on appeal are Claims 6-32, which are set out in the Appendix. Please see Attached Supplemental Appeal Brief, page 1 for correction.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Claims 6, 7, and 16-32 stand or fall together.

Claims 8-15 stand or fall together.

(8) *Claims Appealed*

A substantially correct copy of appealed claims 6-32 appear on pages 7-10 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 19 shows dependency on Claim 1 previously canceled. Claim 19 was correctly amended (Amendment B, Paper #10, filed 24 April 2003) to claim dependency on newly added independent Claim 30. The Appendix did not carry forward the correction to amended Claim 19. The Appellant submitted a corrected version of the Appendix. Please see Attached Supplemental Appeal Brief, Appendix, page 8 for correction.

(9) *Prior Art of Record*

5,513,117	SMALL	04-1996
5,710,886	CHRISTENSEN et al.	01-1998

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- U: Borders.com: PR Newswire, "Borders.com Online Gift Center Rescues Last-Minute Holiday Shoppers," 04 December 1998, Dialog file 20 #03654067; 1pg.
- V: Borders.com: Internet Archive Wayback Machine; www.archive.org; www.borders.com; 11 January 1998; http://web.archive.org/web/*/http://www.borders.com; 2pgs.

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- W: Borders.com: Internet Archive Wayback Machine; [www.archive.org;](http://www.archive.org/www.borders.com)
www.borders.com; 11 January 1998;
[http://web.archive.org/web/19980111035340/](http://web.archive.org/web/19980111035340/http://borders.com) <http://borders.com>; 1pg.
- X: Borders.com: Internet Archive Wayback Machine; [www.archive.org;](http://www.archive.org/www.borders.com)
www.borders.com; 11 January 1998;
[http://web.archive.org/web/19980111035542/](http://web.archive.org/web/19980111035542/borders.com/stores/index.html)
borders.com/stores/index.html; 2pgs.

Items Page 2 of 2

- U: Borders.com: Internet Archive Wayback Machine; [www.archive.org;](http://www.archive.org/www.borders.com)
www.borders.com; 11 January 1998;
[http://web.archive.org/web/19980111040641/](http://web.archive.org/web/19980111040641/borders.com/stores/states/va.html)
borders.com/stores/states/va.html; 2pgs.
- V: PR Newswire; "Nordstrom Launches Online Store at
www.nordstrom.com," 21 October 1998, Dialog file 20 #03175781.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-7, 10, 11, 16-20, 25-27, and 29-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Small (US 5,513,117) in view of Borders.com (a collection of articles cited in Paper #9, PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U). This rejection is set forth in a prior Office Action, mailed on 14 July 2003

Claims 8, 9, and 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Small (US 5,513,117) and Borders.com (a collection of articles cited in Paper #9, PTO-892, page 1 of 2, Items: U-X; and page 2 of 2, Item: U), as applied to Claim 30, further in view of PR Newswire (Paper #9, PTO-892, page 2 of 2, Item: V). This rejection is set forth in a prior Office Action, mailed on 14 July 2003.

(11) Response to Argument

- **Please note the following:**

The Appellant based arguments on the assumption the Examiner intended to reject Claims 10 and 11 as being unpatentable over Small and Borders.com further in view of PR Newswire.

The Examiner intended to cite Claims 10 and 11 under Small and Borders.com further in view of PR Newswire and appreciates the Appellant making this assumption and basing arguments on this assumption.

The Appellant did not comment on the rejection of Claims 25 and 26 as being unpatentable over Small in view of Borders.com. The examiner intended to cite Claims 25 and 26 under Small and Borders.com further in view of Official Notice.

- **The Appellant argues the examiner does not make a prima facie case of obviousness with respect to Claim 30.**

The Examiner maintains the position that motivation exists to combine Small and Borders.com and the previous Office Action establishes a prima facie case.

Small teaches remote electronic ordering of social expression cards, gift giving, and combining a social expression card with a gift certificate for an intended recipient. Small teaches the recipient redeems the gift certificate at a participating merchant. Small teaches the problematical problems of gift giving and stresses convenience in the experience (please see at least abstract; col. 2, lines 1-25). Small further teaches as claimed in the sole independent Claim 30:

- presenting a remotely located user with a selection of social expression card designs;

remote customers using personal computers connected to the greeting card and gift central computer via the public telephone network to preview gift card designs (see at least Fig. 4 (50, 51, 64); Fig. 5 (81); col. 2, line 59 through col. 3, line 9; col. 6, lines 25-65).

- displaying to said remotely located user a list of merchants from which gift certificates are available;

making gift certificate selection from a listing of a number of national merchants (see at least col. 6, lines 8-12).

- in response to user selection of a merchant from said list of merchants, displaying a list of locations for said selected merchant;

Please see Examiner's response to Appellant's arguments below.

- presenting said remotely located user with a selection (of) gift certificates available from said selected merchant;

selecting a particular store and then selecting a certificate dollar amount from a number of pre-programmed dollar amounts (see at least col. 6, lines 8-12); presenting (see at least Fig. 5 (81); Fig. 6 (81); Fig. 7 (105, 106, 114); Fig. 11 (181); Fig. 13 (71); col. 6, line 66 through col. 7, line 35).

- in response to user selection of a card design and gift certificate, delivering a combined social expression card and gift certificate to an addressee designated by said remotely located user.

greeting card and gift certificate selected and delivered to addressee (see at least Fig. 7 (106, 111, 113, 115); col. 2, lines 1-4; col. 8, lines 7-17).

Claim 30: in response to user selection of a merchant from said list of merchants, displaying a list of locations for said selected merchant;

The Examiner agrees with the Appellant's admission on record (Amendment, Paper #10) that a) store locators exists and b) selecting a merchant store that is not located near the recipient would be of little value to

the recipient. This examiner firmly believes that leaving the merchant selection up to chance with regard to geographical proximity to the intended recipient is neither desirable nor perceived to be convenient for the recipient. Since the invention of Small pertains to providing shopping convenience, one of ordinary skill in the art at time of the invention implementing the method of Small would take a prudent course of action to solve the problem of eliminating chance selection of geographical proximity by providing a merchant locator to assist the gift giver with making a merchant location selection convenient for the recipient.

The previous Office Action cited Small listing merchants for selection but did not rely upon Small to teach merchant locations as argued by the Appellant. Borders.com teaches a solution to the problem of eliminating chance selection of a merchant location by providing customers with a merchant and merchant store locator that helps the gift giver determine merchant location (Borders.com: Paper #9, PTO-892, page 1 of 2, Item: U, see page 1). The teachings of Borders.com apply horizontally across gift giving services providing similar customer convenience, and one of ordinary skill in the art would find the teachings of Borders.com useful and pertinent to facilitating gift giver and recipient convenience by eliminating chance in the merchant location selection process (Borders.com: Paper #9, PTO-892, page 1 of 2, Item: X: please see page 1; page 2 of 2, Item: U, see page 1).

The Examiner respectfully believes a prima facie case was established in the previous Office Action.

- **The Appellant argues the rejection of Claims 8-15 is based on speculation about how the Nordstrom system works guided by the Appellant's claims and disclosure. The Appellant argues the examiner is speculating how the Nordstrom system works based on a single sentence.**

The examiner respectfully disagrees with the Appellant's argument on speculation. The Appellant omitted the second sentence of these teachings that completes the authors disclosure:

First sentence- Other built-in conveniences include a multiple shipping feature that allows customer to ship their purchases to different addresses across the country in a single order.

Second sentence- Gift orders can be boxed and shipped directly to multiple recipients (\$4.00 per gift box) or a customer may choose to receive their gift purchases with complimentary flat gift boxes to make personal deliveries (Paper #9, PTO-892, page 2 of 2, Item: V, see page 1).

The examiner firmly asserts there is no speculation regarding the full disclosure. Nordstrom's online gift giving service teaches or suggests built-in shopping conveniences to the customer and teaches or suggests a customer

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designating each recipient of multiple recipients to receive a gift in a single order.

- **Official Notice (Paper #11, regarding privacy expectations and mailing practices).**

The Appellant did not traverse the examiner's assertion of official notice. The common knowledge or well-known in the art statement is taken to be admitted prior art because Appellant failed to traverse or adequately traverse the examiner's assertion of official notice (MPEP 2144.03(C)).

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Robert M. Pond
Patent Examiner
July 26, 2004

Conferees:


Mr. Jeffery A. Smith, Acting Supervisory Patent Examiner, AU 3625


Mr. Joseph Thomas, Supervisory Patent Examiner, AU3626, Appeals Conference
Specialist

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